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10/021,129	12/12/2001	Yeong-Taeg Kim	SAM2.0004	2469

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EXAMINER
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LU, SHIRLEY

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/021,129	KIM, YEONG-TAEG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shirley Lu	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Response to Arguments**

a. Applicant argues that Zigmond does not specifically disclose 'a digital television receiver performing a digital TV function.'

Zigmond indeed supports the above. Note: [7, 25-67]; digital data stream; WebTV. Note original office action.

b. Applicant argues that Zigmond does not specifically disclose 'storing a plurality of advertisement messages in a storage device.'

Zigmond indeed supports the above. Note: (fig. 4, 5, [15, 17-34]; [8, 1-11]; the advertisements are effectively cached at a point in time). Note original office action.

c. Applicant argues that Zigmond does not specifically disclose 'subsequent to storing the plurality of the advertisement messages, using the digital television receiver to receive video data from a digital television service provider.'

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Zigmond indeed supports the above. Note original office action. Note: MPEP 706.02(b). None of the following were met.

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A rejection based on 35 U.S.C. 102(e) can be overcome by:

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
- (B) Amending the claims to patentably distinguish over the prior art;
- (C) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;
- (D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a). See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. If there is no common assignee or inventor and the rejection under 35 U.S.C. 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared. See MPEP Chapter 2300 for more information regarding interferences;
- (E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) within the time period set in 37 CFR 1.55(a)(1) or filing a grantable petition under 37 CFR 1.55(c). See MPEP § 201.13. The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55(a)(3)) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph; or
- (F) Perfecting priority under 35 U.S.C. 119(a) or 120, within the time periods set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.75 which

contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. See MPEP § 201.11 and § 706.02.

d. Applicant argues Zigmond does not specifically disclose 'with the digital television receiver, outputting the plurality of the advertisement messages and the received video data...'

Zigmond indeed supports the above. Both advertisement messages are received video data are output, despite toggling. Note original office action.

e. Applicant argues Zigmond does not specifically disclose 'if a predetermined number of the plurality of the advertisement messages has been output, then disabling the digital TV function of the digital television receiver'

Zigmond indeed supports the above. If a predetermined number of the plurality of the advertisement messages has been output, then the digital TV function is effectively disabled as claimed. Note original office action.

f. Applicant argues Zigmond does not specifically disclose 'after the digital TV function has been disabled, storing a new set of the plurality of advertisement messages in the storage device, and subsequently enabling the digital TV function of the digital television receiver.

Zigmond indeed supports the above. Note paragraphs e and b of this office action.

g. Applicant argues Zigmond does not specifically disclose 'storing the new set...'

Zigmond indeed supports the above. Advertisement messages were effectively downloaded from a network at some point in time. Note original office action.

h. Applicant argues Zigmond does not specifically disclose 'setting the predetermined...'

Zigmond indeed supports the above. The plurality of advertisements paid for are guaranteed to be shown and effectively stored at some point. Note original office action.

- i. Applicant argues Zigmond does not specifically disclose 'providing the storage..'

Zigmond indeed supports the above. The plurality of advertisements paid for are guaranteed to be shown and effectively stored at some point. Note original office action.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 'part of the viewer's TV set') are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- j. Applicant argues Zigmond does not specifically disclose 'storing the plurality...'

Zigmond indeed supports the above. Note paragraph h of this office action.

- k. Applicant argues Zigmond does not specifically disclose 'receiving additional video...'

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., 'cross-over links comprise receiving additional video data...') are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Note original office action. Video programming; program description information.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

I. Applicant argues that 'at the time the claimed invention was made...'

Note CFR 1.130.

**§ 1.130 Affidavit or declaration to disqualify commonly owned patent or published application as prior art.**

- (a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:
- (1) A terminal disclaimer in accordance with § 1.321(c); and
  - (2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

m. Applicant argues non-analogous art.

Note: MPEP 2145.

#### **IX. ARGUING THAT PRIOR ART IS NONANALOGOUS**

A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

See MPEP § 2141.01(a) for case law pertaining to analogous art.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

n. Applicant argues that 'the reference itself must suggest the modification or combination...'

Note: MPEP 2143 and 2145.

#### **2143 Basic Requirements of a *Prima Facie* Case of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).



## **X. ARGUING IMPROPER RATIONALES FOR COMBINING REFERENCES**

### **A. Impermissible Hindsight**

Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking. However, there is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness." See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). For example, motivation to combine prior art references may exist in the nature of the problem to be solved (*Ruiz* at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (*National Steel Car v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)). See MPEP § 2143.01 for a discussion of proper motivation to combine references.

- o. Applicant argues the combination of reference(s) do not specifically disclose 'initializing a counter...'

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 'duration of advertisement and video output') are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Note original office action.

p. Applicant argues the combination of reference(s) does not specifically disclose 'decrementing the counter...'

However, applicant goes on to admit that 'there is mention whatsoever of decrementing a time counter.' Note MPEP 2129 and original office action.

#### **I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART**

A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.").

Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

q. Applicant argues hindsight.

Note MPEP 2145.

## **X. ARGUING IMPROPER RATIONALES FOR COMBINING REFERENCES**

### **A. Impermissible Hindsight**

Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking. However, there is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness." See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). For example, motivation to combine prior art references may exist in the nature of the problem to be solved (*Ruiz* at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (*National Steel Car v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004)). See MPEP § 2143.01 for a discussion of proper motivation to combine references.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

r. Applicant argues that Kim 20020010927 cannot be used to reject the claims under 103a.

Note CFR 1.130 as above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**1. Claim(s) 1-4, 6-8 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (6698020).**

As to claim 1, Zigmond discloses:

A method for operating a digital television receiver, which comprises: providing a digital television receiver (fig. 3, el. 60; col. 7, lines 37-67) performing a Digital TV function (displaying an advertisement col. 7, lines 25-36);

storing a plurality of advertisement messages in a storage device (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

subsequent to storing the plurality of the advertisement messages, using the digital television receiver to receive video data from a digital television service provider (fig. 3, el. 66; col. 8, lines 29-38; col. 7, lines 1-25);

with the digital television receiver, outputting the plurality of the advertisement messages and the received video data (fig. 3, el. 58; col. 8, lines 29-38); and

if a predetermined number of the plurality of the advertisement messages has been output (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47), then disabling the digital TV function (display of the advertisement to the viewer is blocked col. 13, lines 40-47) of the digital television receiver.

As to claim 2, Zigmond discloses:

after the digital TV function has been disabled, such that video data from the digital television service provider are no longer output, storing a new set of the plurality of advertisement messages in the storage device (advertisements continue to be transmitted col. 8, lines 29-39, and new advertisements are stored after an advertisement has reached its desired number viewing times col. 13, lines 40-47); and subsequently enabling the digital TV function of the digital television receiver (ads that have not reached the desired number viewing counts proceed to be displayed col. 8, lines 29-39).

As to claim 3, Zigmond discloses:

performing the step of storing the new set of the plurality of the advertisement messages in the storage device by downloading the new set of the plurality of the advertisement messages from a network (fig. 8, el. 64; col. 8, lines 29-37).

As to claim 4, Zigmond discloses:

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setting the predetermined number such that all of the plurality of the advertisement messages that were stored will be output (advertisers pay for a guaranteed number of exposures col. 14, lines 49-58).

As to claim 6, Zigmond discloses:

providing the storage device as a component of the digital television receiver (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

As to claim 7, Zigmond discloses:

performing the step of storing the plurality of the advertisement messages by downloading the plurality of the advertisement messages from a network (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

As to claim 8, Zigmond discloses:

receiving additional video data from the digital television service provider; with the digital television receiver, outputting the additional video data without outputting the plurality of the advertisement messages (col. 18, line 38 to col. 19, line 9); and limiting a duration that the step of outputting the additional video without outputting the plurality of the advertisement messages can be performed (information relating to program description

that appear in the feed. Since programs change, topics change and appear for a duration; col. 18, line 38 to col. 19, line 9).

### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claim(s) 5, 12-13, 15 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (6698020) in view of Kim (20020010927).**

As to claim 5,

Zigmond teaches outputting the plurality of advertisement messages that were stored to be output (col. 15, lines 17-34; col. 18, lines 29-63).

Zigmond fails to specifically teach a banner and performing the outputting step such that the plurality of advertisement messages that were stored are output as banner as advertisement messages together with the received video data.

In an analogous art, Kim discloses a system of displaying the program signal with the banner [0076].

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to teach performing the outputting step such that the plurality of the advertisement messages that were stored are output as banner advertisement messages together with the received video data, as taught by Kim, so as to not frustrate users who wish to view their chosen program from beginning to end without interruption.

As to claim 12,

Zigmond discloses:

A digital television receiver, comprising: a video decoder for decoding received video bit streams of a selected program to obtain decoded video bit streams of the selected program (col. 6, lines 40-47);

An ad storage device (fig. 5, el. 86) for storing data representing advertisement messages and thereby obtaining stored data (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);



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An ad rendering unit for decoding and rendering the stored data to obtain rendered data (fig. 5, el. 84, 86, 83; [15, 16-34]; [12, 33-43]);

An ad manager unit for reading out the stored data from said banner storage device and for providing the stored data to said banner rendering unit, said banner manager unit generating a disable signal when a predetermined number of the advertisement messages, represented by the stored data, have been read out from the banner storage device (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47); and

Zigmond fails to specifically teach processing banner and a video reconstruction unit for combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes information representing the selected program.

In an analogous art, Kim discloses processing a banner ([0076]) and a system of a video reconstruction unit for combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes information representing the selected program (fig. 8, el. 807; [0076]).

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It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to include processing banner and a video reconstruction unit for combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes information representing the selected program, as taught by Kim, so as to not frustrate users who wish to view their chosen program from beginning to end without interruption.

Kim discloses: an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for outputting the combined video output signal ([0076]).

As to claim 13,

Zigmond discloses:

a system control unit for receiving the disable signal and, in response thereto, for prohibiting said output terminal from receiving the information representing the selected program (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47).

As to claim 15,

a network adapter (inherently inside the STB) for downloading the stored data into said banner storage device from an external network (fig. 7, el. 64; col. 8, lines 29-37; fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

**3. Claim(s) 9-11 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (6698020) in view of Gupta (20040073947), and in further view of Dimitrova (6469749).**

As to claims 9 and 10,

Zigmond fails to specifically teach performing the limiting step by: initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed; decrementing the counter by an amount corresponding to an amount of time that the step of outputting the additional video without outputting the plurality of the advertisement messages is being performed; and when the counter reaches the predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages.

In an analogous art, Gupta discloses a system of performing the limiting step by: initializing a counter to a predetermined value (counter resets to zero [0074]);

incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed ([0074]; [0078]; [0085]);

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to teach performing the limiting step by: initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed, as taught by Gupta, so as to allow monitoring of media and determine which information to output.

Zigmond in view of Kim and in further view of Gupta fail to specifically disclose: decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing the step of outputting the advertisement messages.

In an analogous art, Dimitrova discloses a system of decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages (the commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art to modify Zigmond in view of Gupta system to teach decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing

outputting the advertisement messages, as taught by Dimitrova, so as to allow the system to determine how long to allow the commercial to air.

As to claim 11,

Gupta discloses:

providing the counter as a component of the digital television receiver (fig. 2, el. 180; [0074]).

**4. Claim(s) 14 is/are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (6698020) in view of Kim (20020010927), and in further view of Gupta (20040073947), and in further view of Dimitrova (6469749).**

As to claim 14,

Zigmond discloses: said video reconstruction unit is outputting the information representing the selected program without the rendered data (col. 18, line 38 to col. 19, line 9).

Kim discloses: the rendered data is combined with the decoded video bit streams of the selected program in said video reconstruction unit ([0076])

said video reconstruction unit also configured to selectively output the information representing the selected program without the rendered data (fig. 8,el. 807; [0076]).

Zigmond in view of Kim fails to teach a counter having a value that is incremented.

In an analogous art, Gupta discloses a system of a counter having a value that is incremented ([0074]; [0078]; [0085]);

It would have been obvious to one of ordinary skill in the art to modify Zigmond in view of Kim's system to a counter having a value that is incremented, as taught by Gupta, so as to allow monitoring of media and determine which information to output.

Zigmond in view of Kim, in further view of Gupta's system fail to specifically disclose: said value of said counter being decremented in proportion to an amount of time during and when the value of said counter reaches a predetermined lower limit value, said video reconstruction unit being prohibited from outputting the information.

In an analogous art, Dimitrova discloses a system said value of said counter being decremented in proportion to an amount of time during and when the value of said

counter reaches a predetermined lower limit value, said video reconstruction unit being prohibited from outputting the information (the commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art to modify Zigmond in view of Gupta system to teach decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages, as taught by Dimitrova, so as to allow the system to determine how long to allow the commercial to air.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

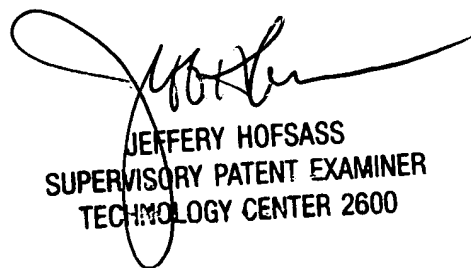
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Lu whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SL



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